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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER
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HM22/0804

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ART UNIT	PAPER NUMBER
SAUNDERS, D	8

DATE MAILED:

08/04/99

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire ONE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-15 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Art Unit: 1644

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-6, 14, drawn to a heparin binding glycoprotein, classified in class 530, subclass 395.
  - II. Claims 7-10, 13, drawn to a method of producing a glycoprotein by an engineered cell, classified in class 435, subclass 69.1.
  - III. Claims 11-13, drawn to a method of chemically glycosylating a protein, classified in class 530, subclass 402+.
  - IV. Claims 15, drawn to a method of covalently bonding a sugar to a natural protein, classified in class 530, subclass 402+.

Claim 13, listed in both Groups II and III will be examined with the limitations of only the elected of these groups.

2. The inventions are distinct, each from the other because of the following reasons:

The products of Groups I and IV are distinct in that Group I encompasses compositions which are naturally occurring glycoproteins, while Group IV encompasses only proteins which are non-naturally glycosylated. Further the product of Group I is limited to a protein that is a heparin binding protein, while the product of Group IV is not thus limited. Products encompassed by the latter would include, for example, carrier proteins/polypeptides with covalently coupled oligosaccharide antigens that would be used as immunogens. A search for one of these groups would thus involve a divergent search from that required for the other group. For this same reason the searches required for Groups II or III are divergent from that required for Group IV.

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The product of Group I is distinct from the glycosylation methods of either Groups II or III, since the product of Group I can be a naturally occurring glycoprotein.

The glycosylation methods of Groups II and III differ in the reagents used, steps conducted, and in their required searches. A reference showing one of these would not necessarily show the other.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their recognized divergent subject matter and different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

3. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth further below.

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Applicant is given ONE MONTH, or THIRTY DAYS, whichever is longer, from the mailing date of this letter within which to comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). In no case may an applicant extend the period for reply beyond the SIX MONTH statutory period. Direct the reply to the undersigned.

Applicant is required to supply a computer readable form (CRF) of the sequence listing, and a statement that the content of the paper and CRF copies are the same and, where applicable, include no new matter as required by 37 CFR 1.821(e), (f) or (g) or 1.825(b) or (d).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Saunders whose telephone number is (703) 308-3976.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Chan, can be reached on (703) 308-3973. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

*David A. Saunders*

DAVID SAUNDERS  
PRIMARY EXAMINER  
ART UNIT ~~102~~ 1644